

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No : 10/620,038
Applicant : Shimek et al.
Filed : July 15, 2003
Title : Soft dried Marshmallow and Method of Preparation

TC/A.U. : 1794
Examiner : Bekker, Kelly Jo

Docket No. : 6126US

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants of the above-identified U.S. patent application submit this Reply to the Examiner's Answer in support of an appeal from the January 12, 2009 rejection of claims 1, 3-27, 29-39 and 81 in this application.

I. ARGUMENTS

A. 35 U.S.C. § 102(e) Rejections

1) 1.131 Affidavit

On page 13 of the Examiner's Answer, the Examiner asserts that various papers submitted as evidence in support of the inventors' 1.131 Affidavits appear to be unrelated and suggested that, taken individually, they do not establish possession of the invention as claimed. Initially, the Appellant notes that this is the first time the Examiner has made such an argument. However, the Examiner has indicated in the past that she has never allowed an application based on a 131 affidavit and, therefore, reopening prosecution at this stage to simply re-affirm that the evidence is related would not appear to be either fruitful or in the best interest of furthering prosecution. Instead, it is simply submitted that the Affidavits filed in this application must be considered with all the other evidence of record in the totality.

The Appellant notes that the Patent Office is required to accept Rule 131 Affidavits at face value, and without investigation. See *1Chisum*, Patents §3.08 [1][a] citing *Herman v. William Brooks Shoe Co.*, 39 USPQ2d 1773, 1777 (S.D. N.Y 1996) (citing Treatise; "the PTO is required to accept Rule 131 Affidavits at face value, and without investigation."). Inventors Susan L. Kamper and James W. Geoffrion declared that the invention was conceived in early April 2002 and samples were made later that month. The evidence submitted was identified as invention record materials. Therefore, the Examiner's assertion that the evidence is unrelated is clearly not in accordance with the Examiner's duty to accept the evidence at face value.

The Examiner's assertion that the evidence does not show moisture, density, water activity and the softening agent claimed is in error. As set forth in the Appeal Brief, page 4 of the evidence shows that hydrated gelatin (foaming and structuring agent)

was added at 6.05% of the base slurry, and that the product had a moisture level of between 1.16 and 12.9. The Examiner also states that "fat appears to be an essential part of the composition in part 1 and fat is not required in the instant invention." However, the claim does not need to recite every element shown in the product to show possession of the claimed invention. Therefore, the Affidavit shows completion of a species of claim 1 prior to the effective date of Roy et al. The Examiner's assertion that there is no evidence to show conception and reduction to practice is in error.

On page 15 of the Answer, the Examiner also states that "just because a confection is soft and chewy does not mean that the confection will have the density and springback factors as instantly claimed." Thus, the Examiner has determined that the Affidavit swearing to conception of the invention prior to the effective date of Roy et al., does not to teach the springback factor claimed because the inventors had not yet quantified the level of softness and chewiness of the product. At the same time, the Examiner finds that Roy et al. must inherently have the springback factor claimed because it shares some common ingredients with the present invention. Appellant submits that such an analysis is just erroneous, and that the Affidavit should be accepted to remove Roy et al. as prior art.

2) Anticipation

Appellant noted in the Appeal Brief that Roy et al. includes hexametaphosphate, which is "necessary to allow the film-forming solution to firmly gel the final mallow mix..." The hexametaphosphate is preferably a sodium salt, although potassium salt can be used. See paragraph 0014 of Roy et al. In paragraphs 0039-0042 of the subject application, it is noted that calcium may be used in certain embodiments of the invention. *Calcium* hexametaphosphate is listed as a potential calcium source. The Examiner erroneously equates the *sodium or potassium* hexametaphosphate necessary in Roy et al. for the *calcium* hexametaphosphate which is not required but can be present by the

current invention and concludes that the product of Roy et al. has the same properties as the claimed invention. See page 16 of the Examiner's Answer.

Claim 1 requires a density of about 0.1-0.35 g/cc and a moisture content of 1-10%. The Examiner points to a moisture content of 1-5% in a dried marbit of Roy et al. The Appellant previously argued that the density in Roy is 1.5-4 pounds per gallons before extrusion and that the density would change when extruded and dried (as the moisture content is reduced by at least half). On page 16 of the Examiner's Answer, the Examiner argued that, because Appellant's Application states that the density of a product before extruding and drying is about 0.1-0.5 g/cc, the argument that the extruding and drying process in Roy et al. would affect the final density is incorrect. However, the Appellant's preferred process does not require drying, and when drying is used, the product is subjected to "a modest drying step." In contrast, Roy et al. must be significantly dried to cut the moisture level in half in order to obtain the required moisture level of from 1-5%. Therefore, the present invention retains its density and the Roy et al. product would not since the moisture is reduced by at least half in the Roy et al. product, and the density would necessarily change with half the water content being removed.

The Examiner argued on page 17 of the Answer that, "as compressibility and bulk compressibility is based on product composition and the degree of aeration provided to the product and since Roy et al. teaches of an aerated confection with substantially the same composition as instantly claimed and with substantially the same density and thus degree of aeration, one of ordinary skill in the art would expect that the product of Roy inherently have substantially the same compressibility and bulk compressibility as instantly claimed..." However, the Examiner has failed to show that Roy et al. has the same density at the same moisture level as the present invention. Thus, the Examiner's argument is flawed. Basically, the Applicant has proven that Roy et al. has both different ingredients which results in distinct attributes, yet the Examiner still dismisses these

distinctions in holding that various specifically required limitations, including the springback factor and glass transition temperature, would, without any specific disclosure on point, are anticipated. Clearly the Examiner admits various distinctions by the continued use of "substantially" when attempting to equate features of Roy et al. with various claim limitations. It is respectfully submitted that these distinctions and the lack of any disclosure on point in Roy et al. to at least the required springback factor and glass transition temperature does not support an anticipatory rejection.

B. Obviousness

The Examiner addressed Appellants non-obviousness arguments on page 18 of the Examiner's Answer. Specifically, the Examiner stated that "the test for obviousness is not whether the features of a secondary reference may be incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references." However, Appellant did not argue that Ziellow cannot be bodily incorporated in Roy et al.; nor did Appellant argue that the claimed invention must be *expressly* suggested in any one or all of the references. Instead, Appellant noted that neither reference teaches or suggests the glass transition temperature or springback factor claimed. Further, Appellant noted that when the prior art teaches away from the claimed invention, it is relevant to the analysis of whether one of ordinary skill in the art would have thought to combine the elements in the fashion claimed.

II. Conclusion

For at least the reasons set forth above, Appellant respectfully submits that the present invention is patentably defined over the prior art of record such that the Examiner's rejections should be reversed and the application passed to issue.

Respectfully submitted,



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